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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,066

12/02/2003

Martin Zimmerling

1941/172

2565

2101

7590

11/27/2006

BROMBERG & SUNSTEIN LLP  
125 SUMMER STREET  
BOSTON, MA 02110-1618

EXAMINER

KOHARSKI, CHRISTOPHER

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/726,066

Applicant(s)

ZIMMERLING ET AL.

Examiner

Christopher D. Koharski

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-32 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8, 18, 19, 23-25, 27, 28, 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-4, 6, 9-17, 20-22, 26, 29 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges Applicant's reply filed 11/07/2006 in which currently claims 1-4, 6, 9-17, 20-22, 26, 29 and 30 are pending for examination.

### ***Response to Arguments***

Applicant's arguments, see remarks, filed 11/07/2006, with respect to the Negre reference (5,643,194) have been fully considered and are persuasive. The rejection of the claims outstanding claims has been withdrawn. However, upon further consideration, the previous ground(s) of rejection are reinstated in view of Prosl et al (4,541,429).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-4, 6, 9-14, 16-17, 20, 26 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Prosl et al. (4,451,429). Prosl et al. discloses an implantable magnetically actuated valve that includes a fluid chamber (24) having an inlet (14) and outlet (16), and an internal magnet (see figure 4) disposed within the fluid chamber. The internal magnet is movable such the displacement of the internal magnet restricts the flow of fluid through the chamber; see 4:57-58 and 7:44-46. An external magnet (M) provides the magnetic field that moves the internal magnet, see figure 2. The magnet is

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capable of displacement movement about the center axis in the to restrict flow and is also capable of rotational movement when the external magnetic is rotated due to the magnetic N-S attraction between magnets and the device allows for this rotational movement since the magnet is sealed but free to rotate about the axis, see figure 4. The fluid chamber and the housing (coating) of the magnet are made from titanium. The internal magnet is spherical in width and cylindrical in height, with housing anchors (72,76). The magnet includes grooves (66) and the device is capable of being used in a subject's ear or skull due to disclose of implantation and the overall size of the device.

***Claim Rejections - 35 USC § 103***

Claim 15 is rejected under 35 U.S.C 103(a) as being unpatentable over Prosl et al. Prosl et al. meets the claim limitations as described above except for various biocompatible coatings.

Regarding claim 15, it would have been obvious to one having ordinary skill in the art at the time the invention was made to coat the various internal parts to facilitate biocompatibility, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as (such as internal implantation, of which silicone is well-known biocompatible material) a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

***Claim Rejections - 35 USC § 103***

Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prosl et al. in view of Rehder et al. (2002/0108623). Prosl et al. meets the claim

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limitation as described above but both fail to include an external indicator including a compass.

However, Rehder et al. discloses an external indicator for use with an implantable magnetically actuated device.

At the time of the invention, it would have been obvious to incorporate the external indicator of Rehder into the invention of Prosl et al. The motivation would have been in order to locate the device for ease of removal if the device is defective and needs to be replaced, see Summary of Rehder.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 7:30am to 4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date:

11/16/2006

*Cdk*

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